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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/876,235      | 06/06/2001  | Jack W. Szostak      | 00786/350009        | 6199             |

21559 7590 04/07/2004

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BOSTON, MA 02110

EXAMINER

FORMAN, BETTY J

| ART UNIT | PAPER NUMBER |
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1634

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 1634

**REPLY TO COMMUNICATION**

The timely submission under 37 CFR 1.129(a) filed on 26 January 2004 is not fully responsive to the prior Office action because Applicant has not complied with the requirement for a showing under 37 C.F.R. § 1.608(b). Since the submission appears to be a *bona fide* attempt to provide a complete reply to the prior Office action, applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer, to submit a complete reply. This shortened statutory period supersedes the time period set in the prior Office action. This time period may be extended pursuant to 37 CFR 1.136(a). If a notice of appeal and the fee set forth in 37 CFR 1.17(e) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant is construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). The appeal stands dismissed.

Applicant argues that no showing under 37 C.F.R. 1.608(b) should be required because: 1) the MPEP § 2308.02 instructs that any claim of foreign priority will not be taken into account when determining whether interference should be declared; 2) the effective filing date of the '943 patent (discounting the foreign priority date) is 17 October 1997; and 3) the effective US filing date of the instant application is 21 January 1997. Hence, Applicant asserts the effective filing date of the instant application is more than three months prior to that of the '943 patent and 37 C.F.R. 1.608(b) should not be applied.

Applicant's comments have been considered. However, 35 U.S.C. §102(g)(1) is expressly conditioned on §104. Section 104(a)(1) permits applicants to "establish a date of invention" in a NAFTA and WTO country. While the MPEP may be misleading regarding

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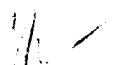
foreign priority, the statute is clear. The date of invention may be established in a NAFTA or WTO country. Hence, the foreign priority for the '943 patent (i.e. 17 October 1996) is considered when determining whether interference should be declared. The date being more than three months from the effective filing date of the instant application, a showing under 37 C.F.R. 1.608(b) is still required.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (571) 272-0741. The examiner can normally be reached on 6:00 TO 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BJ Forman, Ph.D.  
Primary Examiner  
Art Unit: 1634  
April 5, 2004